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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : GIEFER et al.
Serial No : 10/595,502
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Filed : April 24, 2006
For : SHIFTING DEVICE FOR...
Art Unit : 3656
Examiner : Phillip A. Johnson
Dated : September 2, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

In response to the Examiner's Answer of August 6, 2010 Appellant hereby replies.

35 U.S.C. 103(a) rejection citing Murakami and Kim

The Examiner's Answer agrees that Murakami fails to teach and fails to suggest the combination of an adapter having a switch integrated therewith (hereinafter "switch adapter") as featured in claims 1, 15 and 21. The Examiner's Answer takes the position that the deficiency as claimed is cured by Kim since Kim teaches an adapter 41 having a switch corresponding to assembly of elements 50, 51 and 54 integrated therewith. Appellant respectfully disagrees with this position as Kim does not provide any teaching or suggestion for a switch adapter as claimed. Kim discloses a tubular shaft 41 with a rod 50 that passes through the shaft 41 that moves an actuator 51 such that the actuator 51 contacts a leaf switch

52. According to Kim, the rod 50 is in contact with a helical spring 54, which urges the rod 50 axially upwardly to a normal rest position. The mechanical components of the tubular shaft 41, rod 50, actuator 51 and spring 54 of Kim are not a switch as claimed as they do not provide for any electrical features. The Examiner's Answer takes the position that the ordinary meaning of the term "switch" is defined as a device used to open, close or divert an electrical circuit. Based on the ordinary meaning of the term "switch" as defined in the Examiner's Answer, the shaft 41, rod 50, actuator 51 and spring 54 of Kim do not define a switch as claimed. The shaft 41, rod 50, actuator 51 and spring 54 of Kim are all mechanical components that actuate the leaf switch 52. Based on the ordinary meaning of the term "switch" as provided in the Examiner's Answer and a reasonable interpretation of Kim, the leaf switch 52 of Kim is clearly the device that is used to open, close or divert an electrical circuit. The shaft 41, rod 50, actuator 51 and spring 54 of Kim do not provide any features that allow any of these mechanical components to open, close or divert an electrical circuit. The Examiner's Answer provides an unfair interpretation of Kim since the only switch disclosed in Kim is leaf switch 52 and the leaf switch 52 is not integrated with the tubular shaft 41 as claimed.

Murakami and Kim fail to teach and fail to suggest the combination of a switch adapter that is provided above a shift gate as claimed in claims 1, 14 and 21. The Examiner's Answer acknowledges that Murakami as modified by Kim does not expressly disclose the switch adapter being located at a position above the shift gate (page 4, lines 10-11). The Examiner's Answer takes the position that it appears that Appellant is silent as to the criticality of the

switch adapter being located at a position above a shift gate and that the adaptor of Murakami as modified by Kim would not encounter any unexpected results with a portion of the adaptor being positioned below or completely above the shift gate. Appellant respectfully disagrees with this position taken in the Examiner's Answer. Appellant has already expressed that criticality of the location of the switch adapter with respect to the shift gate in the Appeal Brief of April 9, 2010. The arrangement of the switch adapter above the shift gate is critical to the present invention because it allows for the shifting device to be installed much quicker in a motor vehicle when compared to conventional techniques, such as those disclosed in Murakami. Further, the particular arrangement of the one or more lines in the recess of the switch adapter in the present invention allows the shifting device to be shipped directly to the manufacturer without any costly and complicated safety measures being required. These features and corresponding advantages are neither taught nor suggested by Murakami and Kim.

Even assuming Appellant did not state the criticality of the switch adapter being arranged above the shift gate, the prior art taken as a whole must provide some teaching or suggestion for the features claimed. No such teaching or suggestion exists in Murakami and Kim for a switch adapter that is provided above a shift gate. Murakami merely discloses a skeleton frame 9 that has a guide hole 9d to guide a wire into a wire harness 14 wherein the guide hole 9d and the wire harness 14 are located below a slide plate 22. However, this does not provide any teaching or suggestion that would direct a person of ordinary skill in the art toward a switch adapter that is provided above a shift gate as claimed. Kim also does not direct a person of ordinary skill in the art toward a switch adapter that is located above a shift

gate since Kim clearly discloses a leaf switch 52 that is provided within a joystick housing 11. The references as a whole provide no suggestion of using the teachings of Kim to modify the device of Murakami to provide a switch adapter that is located above a shift gate as claimed. Kim does not provide any teaching or suggestion that would direct a person of ordinary skill in the art toward modifying the shift device of Murakami such that the guide hole 9d is located at a position above the shift gate since Kim discloses that it is critical that the switch 52 be provided within a housing. As such, the prior art as a whole takes a completely different approach and does not establish a prima facie case of obviousness as the prior art as a whole does not direct a person of ordinary skill in the art toward critical features as recited in claims 1, 15 and 21 of the present invention.

The Examiner's Answer takes the position that the combination of Murakami and Kim as modified discloses a switch display part that is arranged opposite a switch as featured in claims 5 and 6. The Examiner's Answer states that a display is defined as anything displayed and given the broadest and reasonable interpretation of the limitation "display", the top surface of push button 53 of Kim, which qualifies as a switch, meets the limitation a "switch display part" since this surface is visibly displayed to the operator. This is an unfair interpretation of Kim. The push button 53 of Kim is not a switch as claimed. As defined in the Examiner's Answer, a switch turns on or off or diverts an electrical circuit. The push button 53 of Kim does not turn on or off an electrical circuit, but rather provides a means for actuating a leaf switch 52 with the leaf switch 52 turning on or off an electrical circuit. Push button 53 of Kim does not provide any electrical features and only provides a mechanical means for actuating

the leaf switch 52. Based on a fair interpretation of Kim, Kim only discloses a single switch, which is leaf switch 52. Even assuming that the push button 53 of Kim could somehow be considered as the equivalent of a switch, the push button 53 does not have any display part as claimed. A push button 53 of Kim that merely has a top surface that is visible to an operator of a motor vehicle does not provide a display part for actively displaying something to the operator, such as the current shift state of the vehicle transmission, as claimed. As such, the prior art as a whole does not establish a prima facie case of obviousness with respect to claims 5 and 6 as the prior art as a whole does not teach or suggest critical features of claims 5 and 6.

The invention as claimed presents a combination of features which is neither taught nor suggested by the prior art. The rejection does not present a prima facie case of obviousness. The claimed invention should be considered patentable and nonobvious. Accordingly, it is requested that the rejections of the claims 1-21 based on prior art be reversed.

As to the other points raised in the Examiner's Answer these are already addressed in Appellant's Appeal Brief of April 9, 2010.

For all the above reasons and those stated in Appellant's Appeal Brief, the Board is respectfully requested to overturn the rejections in the last Office Action.

Respectfully submitted
for Applicant,



By: _____
John James McGlew
Registration No. 31,903
McGLEW AND TUTTLE, P.C.

- and -



By: _____
Brian M. Duncan
Registration No. 58,505
McGLEW AND TUTTLE, P.C.

JJM:BMD
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DATED: September 2, 2010
BOX 9227 SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-9227
(914) 941-5600

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 13-0410.